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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,317	01/14/2004	Mary Jo Winterer	AP35651 - 070457.1675	3521
21003 7590 02/05/2010 BAKER BOTTS L.L.P. 30 ROCKEFELLER PLAZA 44TH FLOOR NEW YORK, NY 10112-4498				
EXAMINER LIU, CHIA-YI				
ART UNIT 3695		PAPER NUMBER		
NOTIFICATION DATE 02/05/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DLNYDOCKET@BAKERBOTTS.COM

Office Action Summary

Application No.

10/757,317

Applicant(s)

WINTERER ET AL.

Examiner

CHIA-YI LIU

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5, 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, and 7-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to a Request for Continued Examination (RCE) submitted 1/14/2010. Applicant has amended Claims 1, 5, 7 and 8. Claims 1, 3-5, and 7-8 are pending for examination. Applicant's arguments with respect to claims 1 and 5 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 5 and 7-8 are rejected under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter. To qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. (See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) There is insufficient tie between the recited steps and the recited computer. More specifically, "establishing a credit payment card account using a first financial institution computer" and "applying deductions to said credit card account using a first financial institution computer" do not require the steps

(establishing account and applying deduction) to be performed by a computer.
Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-5, and 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 5 recite the limitation "said cycle is agreed upon by said financial institution." It is unclear whether "said financial institution" is the first financial institution or the second financial institution. It is also unclear whether "said cycle" refers to the periodic cycle or the deduction cycle. Appropriate correction is required.

Claims 1 recites the limitation "at least a portion of said charges are deducted automatically from said depository account on a periodic cycle corresponding to a user-determined deduction cycle, wherein said cycle is agreed upon by said financial institution, and applied to said credit card balance." It is unclear what (said charge or said cycle?) is applied to said credit card balance. The claim language is confusing. Appropriate correction is required.

Claims 1 and 5 recite the limitation "said cycle is agreed upon (to) by said financial institution." An institution is merely a building or building housing such as an organization and does not have the ability to decide. Even if the institution is able to agree and disagree, it is unclear which part of said cycle is being agreed upon (the length of the cycle? the start date of the cycle? the creation of the cycle?). Appropriate correction is required.

As to Claims 3-4 and 7-8, see discussion of Claims 1 and 5 above. These depending claims inherit the same USC 112 deficiency as Claim 1 and 5 and are rejected in the same manner as above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buccì (US 6,786,400) and further in view of DeSane (US 2003/0014018 A1).

As per Claims 1, 5

Buccì ('400) discloses

a consumer depository account (checking account) maintained by a first financial institution holding funds on behalf of said consumer, see Fig 3 (345, 350) and column 2, lines 6-9

a credit payment card for conducting two or more transactions and incurring charges associated with each such transaction, see column 2, lines 2-9 (conduct at least one transaction/conduct at least one other transaction = two or more transactions) and column 7, lines 45-56 (the card can be a credit card)

said card being issued to said consumer by a second financial institution, see column 7, lines 45-56 (The card can be a credit card. Regardless of the type of card...the card number is operable to access both credit account and an account being funded with money. The accounts may be with the same financial institution or separate financial institution)

Buccì ('400) teaches said card further being linked to said depository account (checking account) maintained at said first institution, see column 2, lines 6-14 and column 7, lines 45-56, but fails to explicitly disclose the depository account is used for covering said charges associated with the transaction conducted by the credit payment card. DeSane ('048) teaches depository account (checking account) is used for covering said charges associated with the transaction conducted by a credit payment card, see paragraph 0027 (monthly credit card bills to be paid by direct withdrawal from the debtor's checking account). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Buccì's invention to include the depository account is used for covering said charges associated with the transaction conducted by the credit payment card. One would be motivated to do so for the benefit of allowing user to have money to pay for credit bill when the bill is due.

Bucci ('400) teaches a credit payment card, see column 7, lines 49-51, and a credit line balance, see column 5, line 49-51, but fails to explicitly disclose a payment cycle is associated with said credit payment card and a credit payment card balance reflects a spending limit associated with said credit payment card. Official Notice [now admitted prior art] is taken that it is old and well known to have a payment cycle associated with a credit card and a credit card balance reflecting a spending limit associated with the credit card (For example, Bank of America, Wells Fargo, and most other major banks allows user to associate credit card with a payment cycle and provide customers with credit card balance reflecting his/her spending limit on the card.) Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include a payment cycle is associated with said credit payment card and a credit payment card balance reflects a spending limit associated with said credit payment card. One of ordinary in the skill would be motivated to do so, for the benefit of allowing customers to keep track of the balance and avoiding over-spending.

Bucci ('400) fails to explicitly disclose wherein at least a portion of said charges accumulated using said credit payment card is are deducted automatically from said depository account on a periodic cycle and applied to said credit card balance. DeSane ('048) teaches at least a portion of said charges accumulated using said credit payment card are deducted automatically from a depository account on a periodic cycle, see paragraph 0027 (monthly credit card bills to be paid by direct withdrawal from the debtor's checking account). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include at least a portion of said charges accumulated using said credit payment card is are deducted automatically from said depository account on a periodic cycle and applied to said credit card balance. One of the ordinary skill in the art would be motivated to do so, for the benefit of saving time and preventing late payment.

Bucci ('400) fails to explicitly disclose said cycle corresponding to a user-determined deduction cycle and said cycle is agreed upon by said financial institution. Official Notice is taken that it is old and well known in the art to have a payment cycle determined by a user and agreed to by someone in charge of a financial institution. (For example, the user can be someone who works for the financial institution or anyone that uses a computer and is associated with the financial institution.) Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include said cycle corresponding to a user-determined deduction cycle and said cycle is agreed upon by said financial institution. One would have been motivated to do so for the benefit of making

sure the financial institution does not object to the payment cycle determined for its customer and allows the cycle to be implemented.

As per Claims 3, 7

Bucci ('400) further discloses a credit limit is associated with said card, see column 11, lines 4-5 and column 6, line 40 (credit limit associated with the credit account) but fails to explicitly disclose the credit limit is reduced based on said charges, and refreshed automatically as a function of said deducting means, Official Notice [now admitted prior art] is taken that it was old and well known in the art to reduce credit limit base on charges and refresh credit limit automatically as a function of deducting means. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include which limit is reduced based on said charges, and refreshed automatically as a function of said deducting means. One of ordinary skill in the art would be motivated to do so for the benefit of keeping updated record of how much the cardholder can spend using the credit card.

As per Claims 4, 8

Bucci ('400) does not specifically disclose billing means operated by said second financial institution for periodically informing said consumer of said charges made on the card and of the amount received from said consumer depository account to cover said charges. Official Notice [now admitted prior art] is taken that it was old and well known in the art to for a credit card company to inform consumer periodically of the charges made on his/her credit card and of the amount received to cover the charges. (For Example, monthly credit card statements) Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include billing means operated by said second financial institution for periodically informing said consumer of said charges made on the card and of the amount received from said consumer depository account to cover said charges. One of ordinary in the skill would be motivated to do so, for the benefit of allowing customers to keep track of the balance and avoiding over-spending.

Also, Examiner notes that, as per MPEP § 2144.03(C), the statements of Official Notice made in the art rejection that have not been traversed have been established as admitted prior.

Response to Arguments

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

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(i.e., the ability of financial institution customers to determine payment cycle) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 1 and 5 merely teaches a "user-determined-cycle" and does not limit the user to be a customer of the financial institution. The term "user" merely means "someone use uses something" (for example, a computer user) Therefore, Applicant's argument is not persuasive.

In response to applicant's argument that it is not obvious to combine the teachings of Bucci with the teachings of DeSane, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Bucci teaches conducting transaction using credit line or funds in an account wherein the credit line and the funds can be associated with the same or different financial institutions, see Abstract of Bucci, but fails to explicitly disclose the depository account is used for covering said charges associated with the transaction conducted by the credit payment card. DeSane ('048) teaches depository account (checking account) is used for covering said charges associated with the transaction conducted by a credit payment card, see paragraph 0027 (monthly credit card bills to be paid by direct withdrawal from the debtor's checking account). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the depository account is used for covering charges associated with transaction conducted by a credit payment card, as taught by DeSane in the system of Bucci, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. One would be motivated to do so for the benefit of allowing user to have money to pay for credit bill when the bill is due. Bucci ('400) fails to explicitly disclose wherein at least a portion of said charges accumulated using said credit payment card is are deducted automatically from said depository account on a periodic cycle and applied to said credit card balance. DeSane ('048) teaches at least a portion of said charges accumulated using said credit payment card are deducted automatically from a depository account on a periodic cycle, see paragraph 0027 (monthly credit card bills to be paid by direct withdrawal from the debtor's checking account). Both Bucci and DeSane are directed toward account banking and billing system. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include at least a portion of said charges accumulated using said credit payment card is are deducted automatically from said depository account on a periodic cycle and applied to said credit card balance. Since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and

one of ordinary skill in the art would have recognized that the results of the combination were predictable. One of the ordinary skill in the art would be motivated to do so, for the benefit of saving time and preventing late payment. Therefore, Applicant's argument is not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The Examiner has provided reasons to combine in the above 103 rejection. Furthermore, the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Therefore, Applicant's argument is not persuasive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHIA-YI LIU whose telephone number is (571)270-1573. The examiner can normally be reached on Mon-Thur alternating Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HANI KAZIMI can be reached on (571) 272-6745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CHIA-YI LIU
Examiner
Art Unit 3696

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691